REMARKS

In the Office Action, the Examiner noted that Claims 6-16 had been amended to recite a method. Applicant thanks the Examiner for so noting. However, the Examiner also stated that "[e]lection was made **without** traverse in the reply filed on August 25, 2005." (emphasis in original). In fact, on page 6 of its August 22, 2005 Amendment (presumably received in the Patent Office on August 25, 2005), Applicant specifically stated: "Applicant hereby elects invention I **with** traverse." (emphasis added).

The Examiner then rejected claims 1-17 and 19-27 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In response, Applicant has amended the specification on page 6, lines 14-15 and 27-31 to comply with the written description requirement. The amendment to lines 14-15 does not represent new matter, and support can be found at, *inter alia*, page 4, line 35 to page 5, line 5. The amendment to lines 27-31 does not represent new matter, since it is merely a correction of the translation. Additionally, the Examiner pointed out that the phrase "...removed from the coating again without a race" was unclear. The phrase in the specification actually read as "...without at race". This was merely a typographical error and should have read as "...without a trace." However, this is rendered moot due to the amendment to the specification. Therefore, Applicant respectfully requests reconsideration and removal of this ground of rejection.

The Examiner then rejected claims 1-17 and 19-27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, Applicant has amended claim 1 to provide antecedent basis for the phrase "the coating." Applicant has amended claim 2 to clarify

how the steps of claim 2 fit in with the steps of claim 1, and steps 2 and 3 of claim 2 have been deleted. Claim 2 has additionally been amended to recite "residual deposits" rather than "residual coatings", which finds support in the specification as amended in the present Amendment. Applicant has amended claim 1 to provided antecedent basis for the phrase "the partially or completely cured coating" in claim 2 and to eliminate antecedent basis issues for the phrase "the pointed edges" in claim 2. Claim 4 has been amended to recite "residual deposits" rather than "residual coatings", which finds support in the specification as amended in the present Amendment. Claims 2, 4, 5, 10, and 25 have each been amended to eliminate the phrases "in particular" and "preferably" as necessary. Claims 13 and 14 have been canceled. Claims 15 and 26 have been amended to point out that either hydrocarbons or esters must be present (but both need not be). Additionally, claim 15 has been amended so that "4 to 12" references the number of carbon atoms in the solvent hydrocarbons, esters or alkoxy esters. Claim 17 has been amended to delete "all residue" and replace it with the phrase "the applied coating" which has antecedent basis in claim 1. Claim 20 has been amended to delete "alcohol" and replace it with "polar, organic", which has antecedent basis in claims 3 and 19. Additionally, claims 20 and 21 have both been amended to delete the problematic phrase "independently thereof." Claim 24 has been amended according to the Examiner's suggestion to recite proper Markush terminology. Claim 26 has been amended to clarify that the phrase "with 6 to 10 carbon atoms" refers to the number of carbon atoms in the solvent hydrocarbons, esters or alkoxy esters. These amendments are believed to overcome all of the rejections noted. Therefore, Applicant respectfully requests removal of this ground of rejection.

With reference to the Examiner's assertion in claim 11 that "it is not clear what is meant by acrylic glass. Glass is typically silicon dioxide", Applicant avers that acrylic glass is a form

of glass and has defined it as such on page 7, line 23 of the specification. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner then objected to claim 6 under 37 CFR 1.75(c) as being of improper dependent form for faling to further limit the subject matter of a previous claim. In response, Applicant has canceled claim 6. Therefore, this objection is rendered moot.

The Examiner next rejected claims 1-3, 5-16, and 19-27 under 35 U.S.C. 103(a) as being unpatentable over Bock et al. (U.S. Pat. No. 6,020,419). As an initial matter, Applicant has canceled claims 6, 7, 9, 13, and 14. With respect to the remaining rejected claims, Applicant requests reconsideration and removal of the rejection.

More particularly, Applicant avers that it would not be obvious to one of ordinary skill in the art to modify the disclosure of Bock in such a way as to create that which Applicant claims as the invention. The Examiner makes the unfounded assumption that the letter "m" as used in Table 3 of the Bock reference refers to "micron, [as] it would not make sense to have a 30 meter film thickness." However, the Bock patent is concerned with **nanoscale** measurements, not microscale measurements.

For example, the title of Bock's patent is "Transparent Coating Compositions Containing **Nanoscale** Particles and Having Improved Scratch Resistance." (emphasis added). Furthermore, Bock states that "[t]he present invention relates to transparent coating compositions containing a binder and...a material consisting of **nanoscale** primary particles..." (Col. 2, lines 61-64) (emphasis added). Additionally, under the "Detailed Description of the Invention" section of the patent, the very first sentence states that "[t]he transparent coating compositions containing solid **nanoparticles** according to the invention..." (Col. 3, lines 17-18) (emphasis added). Finally, the only use of the unit "μm" is in reference to a silica flour used as grit in

washing. (Col. 8, lines 40-43). Otherwise, the terms "micron", "μ" and "μm" do not seem to appear anywhere in the patent.

Therefore, while the Examiner assumes that "m" means micron, it is *much* more likely that the "m" was a simple misprint of the letter "n", which is the symbol for nano (which is, after all, what the Bock patent is concerned with). What was most likely meant by this reference was "nm", meaning "nanometer".

Furthermore, the Examiner states that "[t]he particles are below 200 nm [in the Bock reference], which is lower than Applicant's claimed range [of 2 to 30 μm], but it would have been obvious to one of ordinary skill in the art to have optimized the particle size through no more than routine experimentation." However, the Examiner fails to take into account the fact that Bock specifically teaches away from using anything approaching the size that Applicant claims. Bock states that that which is used are "**nanoscale** materials." (Col. 3, line 40) (emphasis added). Applicant's claimed size range of between 2 and 30 μm can hardly be said to fall into the nanoscale. Therefore, since Bock teaches that the materials **must** be on the nanoscale, Bock specifically teaches away from using materials which fall onto the microscale.

Even if it were obvious to one of ordinary skill in the art to modify the Bock reference (which Applicant does not concede), that which the Applicant claims as the invention still would not be created. Bock teaches a "**transparent** coating." (Col. 1, line 8; Col. 2, line 61; and claims 1-10). However, claim 1 as amended in the present Amendment recites that the thickness of the coating must be from 10-50 μm and that the particles used must have an average diameter size of from 2-30 μm. Therefore, the coating of the present invention is not transparent, as is taught and required by the Bock reference. Regardless of the amount of routine experimentation,

a coating that is 10-50 μm thick with particles having average diameters of 2-30 μm will never be transparent. Therefore, Applicant respectfully requests removal of this ground of rejection.

The Examiner then rejected claims 1-3, 5-7, 10-16, 19, 22, and 24-27 under 35 U.S.C. 103(a) as being unpatentable over EP 665252 ("Okamoto" or "the Okamoto reference"). As an initial matter, Applicant has canceled claims 6, 7, 13, and 14. With respect to the remaining rejected claims, Applicant requests reconsideration and removal of this ground of rejection.

Applicant avers that it would not be obvious to one of ordinary skill in the art to modify the Okamoto reference in order to create that which Applicant claims as the invention because Okamoto is concerned with a different area of expertise than is Applicant's invention. Furthermore, this difference is already implicitly recognized by the Patent Office. The Okamoto reference issued in the United States as U.S. Patent No. 5,519,089 ("the '089 patent"), and the U.S. Classifications noted on the face of the '089 patent are 525/123 and 526/279. According to the Patent Office website, both classes 525 and 526 are "Synthetic Resins or Natural Rubbers—Part of the 520 Series." However, the present application is currently classified as being in the 428/435, 427/372.2, 427/402, and 428/426 classes. According to the Patent Office website, class 427 is "Coating Processes" and class 428 is "Stock Material or Miscellaneous Articles." If the Okamoto reference and the present application were actually in the same area of skill, then they should share at least one class in common.

Even if it were obvious to one of ordinary skill in the art to modify the Okamoto reference (which Applicant does not concede), that which Applicant claims as the invention still would not be created. The coating thickness claimed in amended claim 1 ranges from 10 to 50 μm. This is a vast difference from the 200 μm thickness that Okamoto teaches is necessary to achieve the required tensile strength. (pg. 12, lines 57-58). Applicant notes that Okamoto

mentions a thickness of about 1 to 1,000 μm (pg. 10, lines 16-17), but this is only in reference to using the coating as a paint, not as a coating on glass; the coating on glass is specifically taught to be 200 μm (pg. 12, line 57). Therefore, even if one of ordinary skill in the art were to modify the Okamoto reference, a coating thickness of 10 to 50 μm would not be achieved.

Additionally, the Examiner states that "[t]he particle size of the pigments is not stated, but it would have been obvious to one of ordinary skill in the art to have optimized the particle size through no more than routine experimentation." However, Okamoto specifically teaches that "[t]he average particle diameter of dispersed copolymer in the aqueous dispersion is conveniently in the range of from 0.01 to 1 μm, in particular, from 0.02 to 0.6 μm." (pg. 9, lines 24-25). In contrast, claim 1 as amended recites "particles having an average diameter of 2 to 30 μm." Since Okamoto specifically teaches away from using particles having a diameter size greater than 1 μm, it would not be obvious to utilize particles having a diameter size greater than 1 μm, which is what Applicant claims. Therefore, Applicant respectfully requests removal of this ground of rejection.

Finally, the Examiner rejected claims 4 and 17 under 35 U.S.C. 103(a) as being unpatentable over Bock et al. (US Patent No. 6,020419) taken in view of DE 10017363 ("the '363 reference"). In response, Applicant has amended claim 4 to reflect the correct translation (for the same reason that the specification was amended, as noted above). Therefore, Applicant respectfully requests reconsideration and removal of this ground of rejection.

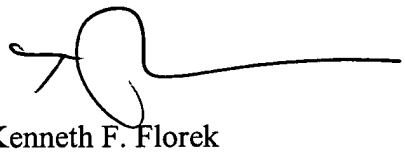
More particularly, Applicant avers that the Bock reference does not apply for the reasons given above. With reference to claim 4, Applicant avers that the '363 reference does not apply to claim 4 as amended. The Examiner states that " '363 teaches that an acrylate coating on glass is a protective varnish that can be removed without damaging the glass...'363 [teaches] that an

acrylate coating may be removed from glass without damaging the glass." However, claim 4 as amended recites the step of removing glass deposits that were present due to manufacturing or contamination, not due to coating. Therefore, Applicant respectfully requests removal of this ground of rejection in reference to claim 4.

With reference to claim 17, Applicant avers that the Examiner is misapplying the '363 reference. The '363 reference teaches throughout the specification (and in every single claim) a temporary coating rather than a permanent acrylate coating, as the Examiner states. However, Applicant is not claiming a mere temporary coating, and there is no teaching or disclosure in either the '419 patent or the '363 reference that shows how a permanent coating (as Applicant claims) can be removed. Therefore, Applicant respectfully requests removal of this ground of rejection in reference to claim 17.

In light of the foregoing amendments and remarks, Applicant respectfully submits that the claims of the present application are in proper form for allowance. Early and favorable consideration are therefore earnestly solicited.

Respectfully submitted,



Kenneth F. Florek
Reg. No. 33,173

MAILING ADDRESS

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989